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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,624	09/26/2003	Richard H. Selinfreund	VTI-107.1B(US)	8082
47670 7590 01/23/2007 KELLEY DRYE & WARREN LLP 400 ATLANTIC STREET 13TH FLOOR STAMFORD, CT 06901			EXAMINER FRANKLIN, JAMARA ALZAIDA	
			ART UNIT 2876	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/672,624

Applicant(s)

SELINFREUND ET AL.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 20, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2006 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Narusawa et al. (US 6,527,173) (hereinafter referred to as 'Narusawa').

Narusawa teaches an IC card (crude card 26) and method for authenticating the IC card comprising a substrate, said substrate having a semiconductor integrated circuit (IC module 53) and one or more optical data (data in the computer generated holograms (CGHs)) deformations incorporated therein that are representative of digital data; the optical data deformations being associated with a transient optical state change security material (metal layer 36) (col. 5, line 59- col. 6, line 3);

the IC card wherein the transient optical state change material is associated with the optical data deformations to provide at least two optical data reads when the optical data deformations are read by an optical reader (col. 10, lines 5-6);

the IC card wherein one optical data read is indicative of valid data, while the other optical data read is indicative of invalid data;

the IC card wherein the deformable or deformation-derived optical data comprise pits and lands (see figures 3(b)-3(e)); and

the method of determining the locations where which transient optical state change materials are located on the authentic IC card (col. 8, lines 36-42);

the method wherein the optical data change is transient as the optical state security change material reverts back from an optical state to an initial state within a time interval; and

the method wherein the time interval between optical states may be predetermined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narusawa in view of Setani (US 4,963,464).

The teachings of Narusawa have been discussed above.

Narusawa lacks the teaching of pits comprising two distinctly different depths.

Setani teaches an IC card comprising a substrate having one or more optical data deformations wherein pits of the optical deformations comprise two distinctly different depths (see figures 5 and 8).

One of ordinary skill in the art would have readily recognized that providing the invention of Narusawa with pits having two distinctly different depths would have been beneficial for increasing the amount of data incorporated into the card. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the teachings of Narusawa with the aforementioned teaching of Setani to expand the card's storage capabilities.

Response to Arguments

7. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive.

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In response to the argument that Narusawa does not teach use of a transient state change material on the card as defined in the specification of the present patent application, the examiner submits that the hologram as disclosed in the Narusawa invention is indeed formed of a state change material in that the state of the material, visually, is changed depending upon the visual perspective of the viewer toward the card. Again, such is the inherent characteristic of a hologram. Therefore, the Narusawa invention reads upon the claimed invention as broadly interpreted.

In response to applicant's argument that there is no suggestion to combine the Narusawa and Setani references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine the teachings of Narusawa with the pits comprising two distinctly different depths as taught by Setani is found in knowledge generally available to one of ordinary skill in the art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Colgate, Jr. (US 5,786,587) teaches an enhancement of chip card security.

Prancz (US 6,170,880) teaches a data carrier with a module and a hologram.

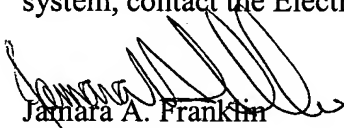
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389.

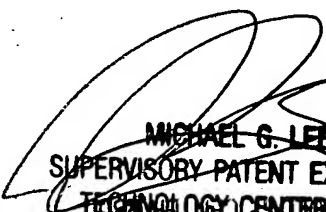
The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
January 12, 2007


MICHAEL G. LEE
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